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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/725,919

12/02/2003

Frederick Enns

3149

2101

7590

12/27/2005

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EXAMINER

TON, DANG T

ART UNIT

PAPER NUMBER

2666

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/725,919	Applicant(s) ENNS ET AL. <i>aca</i>	
	Examiner DANG T. TON	Art Unit 2666	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-29 and 105-117 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-29 and 105-117 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2666

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

2. Claims 14-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 14 lines 12-13, " the network" has no antecedent basis. The same is true with the terms " The asymmetric network" recited in claims 15 and claim 24; " The two way asymmetric network" recited in claims 17-23; " the network" recited in claims 24-25; and " The wireless network" recited in claims 26-29.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims

Art Unit: 2666

are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 14-29 and 105-117 are rejected on the ground of nonstatutory obviousness-type double patenting as being

Art Unit: 2666

unpatentable over claims 1-7 of U.S. Patent No. 6,785,288.

Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following formalities:

For claims 14-29 and 105-117, the claims 1-7 of U.S. Patent No. 6,785,288 disclose a high speed internet access system comprising :

an independently operating downstream controller for transferring information to the remote processor devices; an independently operating upstream controller for receiving information from the remote processor devices; a configuration manager utilizing each of the upstream and downstream controllers to assign and, by obtaining feedback from the remote processor devices, to confirm assignment of an IP address to a remote processor device based on a detected identification of the remote processor device when connected to and operating on the asymmetric communication system; and wherein the upstream controller includes digital signal processors for analyzing and registering in a memory the quality of upstream transmissions by the remote processor devices;

wherein assignment of upstream channels to send remote processor devices is made in accordance with information analyzed by the digital signal processors;

wherein the downstream controller utilizes quadrature amplitude modulation techniques for transmitting digital beta signals downstream to the remote processor devices;

wherein the remote processor devices utilizes VSB modulation techniques for encoding information signals transmitted upstream to the upstream controller;

wherein the remote processor devices includes a processor for receiving network operating software automatically downloaded from configuration manager;

wherein the configuration manager issues control packets that assign one of shared channel used and dedicated channel use two-way remote processor device;

wherein the configuration manager issues the control packet containing information that assigns the class of service level for a remote processor device connected to the network.

NOTE: See the claims 1-7 of U.S. Patent No. 6,785,288.

Applicant's claims 14-29 and 105-177 merely broaden the scope of the claims 1-7 of U.S. Patent No. 6,785,288 by eliminating the terms "wherein the upstream controller includes digital signal processors for analyzing and registering in a memory the quality of upstream transmissions by the remote processor devices" from claim 1 of the patent. It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re karlson, 136 USPQ 184 (CCPA). Also note Ex Parte Raine, 168 USPQ 375 (bd. App. 1969); omission of a reference element whose function is not need would be obvious to one skilled in the art.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the

Art Unit: 2666

invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 14,25, and 105 are rejected under 35 U.S.C. 102(e) as being anticipated by Sistanizadeh et al. (5,790,548).

For claims 14,25,and 105, Sistanizadeh et al. disclose an universal access multimedia data network comprising an independently operating downstream controller for transferring information to the remote processor devices, an independently operating upstream controller for receiving information from the remote processor devices, and a configuration manager utilizing each of the upstream and downstream controllers to assign (see column 4 lines 5-20)and, by obtaining feedback from the remote processor devices, to confirm assignment of an IP address to a remote processor device based on a detected identification of the remote processor device when connected to and operating on the system (see column 10 lines 1-6).

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 22-24, 26, 112-115 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sistanizadeh et al. in view of Kwok et al. (2003/0108048).

For Claims 22-24, 26, 112-115, Sistanizadeh et al. disclose all the subject matter of the claimed invention with the exception of receiving operating software automatically downloaded from the network and assigning the class of service level for a device in a communications network. Kwok from the same or similar fields of endeavor teaches a provision of operating software automatically downloaded from the network and assigning the class of service level for a device (see paragraph 0045). Thus, it would have been obvious to the person of ordinary skill in the art at the time of the invention to use operating software automatically downloaded from the network and assigning the class of service level for a device as taught by Kwok in the communications network of Sistanizadeh et al.

The operating software automatically downloaded from the network and assigning the class of service level for a device can be implemented/modified into the network of Sistanizadeh et al. since it does teach updating the database. The motivation for using operating software automatically downloaded from the network and assigning the class of service level for a device as taught by Kwok into the communications network of Sistanizadeh et al. being that it provides much higher utilizations while maintaining the guaranteed QoS.

Art Unit: 2666

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Enns et al. (6,658,010) is cited to show a system which is considered pertinent to the claimed invention.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANG T. TON whose telephone number is 571-272-3171. The examiner can normally be reached on MON-WED, 5:30 AM-6:00 PM and Thur 5:30-9:30 A.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RAO SEEMA can be reached on 571-272-3174. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


DANG TON
PRIMARY EXAMINER

Art Unit: 2666

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D. Ton